

REMARKS

Status of Claims

Claims 1-52 are pending in the application. Claims 1-11, 18-31 and 36-52 are withdrawn from consideration. Claims 12-17 and 32-35 are rejected.

Claim Amendments

Claims 12, 16 and 34 are amended herein. Claims 12 and 16 are amended currently to overcome a rejection under 35 USC §112. Claim 34 is amended herein to overcome a claim objection.

Objection to the Claims

Claim 34 is objected to as it recites assays that are not applicable to the elected group being examined, as well as an incorrect word, "ELIZA" on line 3.

Applicants submit that claim 34 has been amended herein to include appropriate assays for the detection of the transcript of TADG-15 and the word "ELIZA" has been removed since the correct word "ELISA" describes an assay for detection of protein and is not applicable to the elected group being examined.

In view of the appropriate corrections presented supra, Applicants respectfully request that the objection to claim 34 be withdrawn.

Claim rejection under 35 USC §112

Claims 12-17 and 32-35 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The

Examiner states that in view of the fact that the Applicants are in possession of only one species of TADG-15 nucleic acid, which is SEQ I.D. NO: 1, Applicants cannot broadly claim a kit and an antibody encompassing and specific for all TADG-15, tumor derived gene-15 nucleic acid. Further, the Examiner states, the specification is not enabling for the use of all TADG-15 nucleic acids within a kit and probes specific for said an undefined and uncharacterized TADG-15 nucleic acid.

Applicants submit amended claims 12 and 16. Claims 12 and 16 have been amended to recite the limitation imposed by SEQ I.D. NO:1.

In view of the amendments presented supra, Applicants respectfully request that the rejections of said claims under 35 U.S.C. §112 be withdrawn. Since Claims 13, 14 and 15 depend from claim 12 and claim 17 depends from claim 16, Applicants request that the rejection of claims 13, 14, 15 and 17 be also withdrawn. Claims 32-35 read on a hybridization assay to detect TADG-15 nucleic acid in an individual by the method and kit outlined in claims 12-17. Thus, in view of the amendment to said claims, the Applicants request that the rejection of claims 32-35 be withdrawn.

Claim 17 is further rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant claims as the invention. The Examiner states that claim 17 is not clear in stating "Means for detecting the label"- as the

end-point of the method comprised in the kit involves detection of TADG-15 mRNA and not the label. Applicants traverse this rejection.

Applicants submit that claim 17 describes the kit of claim 16 to be consisting of a label, which is attached to the probe for detecting TADG-15 transcript; and the kit further contains means for detecting the label. The label provides for a means of detecting the target nucleic acid (TADG-15) following hybridization with the probe. Hence, by providing for the means (reagents or machines) of detecting the label one is providing for the detection of the target nucleic acid, which is TADG-15. The label can be fluorescent or radioactive. The methodology for detecting specific target in a sample is known and standard in the art.

In view of the arguments presented supra, the Applicants respectfully request that the rejection of claim 17 be withdrawn.

Double Patenting Rejection

Claims 12-17 and 32-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 5,972,616 (issued October 26, 1999). The Examiner states, that although the claims are not identical, they are not patentably distinct from each other as the active steps are the same, reading on detecting mRNA bound by a probe with hybridization. The Examiner further states that though the instant invention claims a kit, the kit is regarded as an intended use and carries no patentable weight. Applicants traverse this rejection.


Applicants submit amended claims 12 and 16, which have been amended to include the limitations imposed by SEQ I.D. NO:1. Hence, although the active steps read on detection of mRNA bound by a probe (which is a standard technique to detect transcript of any gene in the art), Claim 11 of the issued patent reads on a method of detecting expression of the entire TADG-15 protein while the claims of the instant invention read on a method of detecting the transcript of TADG-15 encoded by SEQ I.D. NO:1, in a sample.

In view of the arguments and amendments to the claims presented supra, Applicants respectfully request that the double patenting rejection of claims 12-17 and 32-35 be withdrawn.

This is intended to be a complete response to the final Office Action mailed September 25, 2006. If any issues remain outstanding, the Examiner is respectfully requested to telephone the undersigned attorney of record for immediate resolution.

Respectfully submitted,

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